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PATENT
Attorney Docket No. 5725.0835-00
Customer No. 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Véronique DOUIN et al.

Serial No.: 09/766,403

Filed: January 22, 2001

For: NANOEMULSIONS COMPRISING AT
LEAST ONE AMPHIPHILIC LIPID, AT
LEAST ONE OIL, AND AT LEAST
ONE NONIONIC POLYMER, AND
USES THEREOF

Group Art Unit: 1619

Examiner: A. Berman

#6
HKO
2-6-02

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

In the Office Action dated December 31, 2001, the Examiner has required Applicants to elect a single species from each of the following groups a, b, and c for prosecution on the merits:

- a. polymers disclosed at pages 6-9,
- b. amphiphilic lipids disclosed at page 20, line 22 to page 21, line 14, and
- c. additional ionic amphiphilic lipids disclosed at page 26 through page 36, line 14.

(Office Action dated December 31, 2001, page 2.)

Applicants traverse this requirement on the ground that it would not be unduly burdensome for the Examiner to conduct a search for all the claimed compositions, as it

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is likely that art encompassing each of the elected species would also encompass the other claimed species. Applicants do not make any statement regarding the obviousness of one species relative to any other, nor should one be inferred. Applicants merely assert that a search of all the claimed species would not be unduly burdensome.

Nonetheless, to further prosecution, Applicants elect, with traverse, the following three species for prosecution on the merits:

- a. polycondensate of polyethylene glycol comprising 150 or 180 mol of ethylene oxide, stearyl alcohol, and methylenebis(4-cyclohexylisocyanate) (SMDI) (page 6, lines 18-20, and page 8, lines 2-4),
- b. polyethylene glycol isostearate (page 21, line 3), and
- c. behenyltrimethylammonium chloride (page 27, formula (IV) and page 36, lines 8 and 9).

Applicants respectfully submit that claims 1-9, 11-21, 23-30, and 50-85 read on the elected species of invention.

Accordingly, Applicants respectfully request that all of the claimed species be examined in this application. If the Examiner chooses to maintain the election requirement, however, Applicants expect the Examiner, if the elected species are found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, and then to extend the search to a reasonable number of the non-elected species, as is the Examiner's duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121. In any case, the election of species requirement should be withdrawn in view of the foregoing remarks.

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